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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,461	01/22/2004	Marvin R. Blumberg	P60530US6	4014
136 7590 03/22/2007 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER PAULA, CESAR B	
			ART UNIT 2178	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/761,461	Applicant(s) BLUMBERG, MARVIN R.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-78 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 58 is/are allowed.
- 6) ☒ Claim(s) 54-57, 59, 60 and 64-68 is/are rejected.
- 7) ☒ Claim(s) 61-63 and 69-78 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6-06, 7-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed on 12/13/2004.

This action is made Final.

2. In the amendment, claims 69-78 have been added. Claims 54-78 are pending in the case. Claims 54, 58, and 68 are independent claims.

Information Disclosure Statement

3. The IDSs filed on 6/26 and 7/27/2006 have been considered by the Examiner.

Priority

4. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 120, and 119(e), and based on U.S provisional application # 60/117,246, CIP of 09/912,509(Pat.6,799,303), and PCT/US00/01890 filed on 1/26/1999, 7/26/2001, 1/26/2000, which papers have been placed of record in the file.

Drawings

5. The drawings filed on 1/22/2004 have been accepted by the Examiner.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 64, and 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite letter input elements only containing the letters "R, and Q", and "R and U" respectively. The Examiner was unable to find an adequate written description of these limitations in the specification

8. Claims 64, and 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite letter input elements only containing the letters "R, and Q", and "R and U" respectively. The Examiner was unable to find an adequate written description of these limitations in the specification, which allows one of ordinary skill in the art to make and use these limitations.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 54-57, and 59-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,799,303, hereinafter 303, in view of Blumberg (Pat.# 5,664,896, 9/9/1997), hereinafter 896.

Regarding independent claim 54, claim 6 of 303 fails to explicitly teach *a keyboard having at least thirteen operator-selectable letter input elements*. However, 896 teaches associating several letters with each key in a keyboard, having 14 keys, for entering desired letters for high speed entry of text. Words which match the sequence of letter keystrokes are presented to the user-- (col.13, lines 4-20, 50-col.14, line 54, and fig.9). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

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Regarding claim 55, which depends on claim 53, 303, and 896 fail to explicitly disclose: *one of the letter input elements includes the letters A and B, one of the letter input elements includes the letters E and F and one of the letter input elements includes the letters T and U.* However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because 896 teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 56, which depends on claim 53, 303 fails to explicitly teach *one of the letter input elements includes at least the letters J and K.* However, 896 discloses a key that is assigned the letters “J”, “K”, and “Q” (fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Regarding claim 57, which depends on claim 53, 303 fails to explicitly teach *a one of the letter input elements includes at least the letters V and W.* However, 896 discloses a key that is assigned the letters “V” through “Z”, etc (fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Regarding claim 59, which depends on claim 53, 303, and 896 fail to explicitly teach *two of the letter input elements include a letter selected H and a letter selected from the from the group of letters G and group of letters I and O*. However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because 896 teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 60, which depends on claim 53, 303 fails to explicitly teach *a one of the letter input elements includes the letter U and a letter selected from the group of letters R, S and T*. However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 54, 56-57, 60, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Blumberg (Pat.# 5,664,896, 9/9/1997).

Regarding independent claim 54, Blumberg discloses associating several letters with each key in a keyboard, having 14 keys, for entering desired letters for high speed entry of text. Words which match the sequence of letter keystrokes are presented to the user-- *A method for entering letters of an alphabet using a computer having a display device, memory storage and a keyboard having at least thirteen operator-selectable letter input elements, the method comprising assigning more than one letter to at least one letter input element of the keyboard with a majority of the letter elements having only two letters assigned each letter input element such that more than one series of letters results from a single selected letter input element, storing a plurality of words in the memory storage, and displaying on the display device for each entered letter input element, a series of letters that form at least one valid combination, said at least one valid combination being determined from said plurality of stored words the memory storage for a same number of the letter input elements thus far selected--* (col.13, lines 4-20, 50-col.14, line 54, and fig.9).

Regarding claim 56, which depends on claim 53, Blumberg discloses a key that is assigned the letters "J", "K", and "Q" (fig.9-10).

Regarding claim 57, which depends on claim 53, Blumberg discloses a key that is assigned the letters "V" through "Z", etc (fig.9-10).

Regarding claim 60, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters "P, U", and "R" (col.13, lines 4-20, 50-col.14, line 54, fig.9-10).

Claim 68 is directed towards the method of claim 54, except that the keyboard has 10, not 13 input elements (taught by Blumberg's 14 key keyboard), and therefore is similarly rejected.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 55, 59, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg.

Regarding claim 55, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters "P, U", and "R" (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *one of the letter input elements includes the letter A and B, one of the input elements includes the letters E and F, and one of the letter input elements includes the letters T and U*. However, it would have been obvious to a person of ordinary skill

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in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 59, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *two of the letter input elements include a letter selected G and H and a letter selected from the from the group of letters G and group of letters I and O*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 65, which depends on claim 54, Blumberg discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *one of the letter input elements includes only the letters E and F*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 66, which depends on claim 54, Blumberg discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *one of the letter input elements includes only the letters R and U*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 67, which depends on claim 54, Blumberg discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *one of the letter input elements includes only the letters T and U*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Allowable Subject Matter

15. Claim 58 is allowed.
16. Claims 61-64, and 69-78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

17. Applicant's arguments filed 12/13/2006 have been fully considered but they are not persuasive. The Applicant indicates that a terminal disclaimer has been filed to overcome the double patenting rejection (page 9, parag.2). The disclaimer does appear to overcome the double patenting rejection. However, a final decision will be made once the processing of the disclaimer is complete at a later date.

Regarding claim 54, the Applicant indicates that Blumberg fails to explicitly disclose a majority of at least 13 letter input elements have only two letters (page 10). The Examiner disagrees, because Blumberg teaches a keyboard, which has 13 keys. There are 6 keys containing only two characters. This is a majority of two-letter keys in the keyboard, since the next biggest letter keys consist of 1 letter keys, which comprise only 5 keys. Therefore, the two-letter keys comprise a majority of the 13 key keyboard.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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I. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

3/19/2007